DETAILED ACTION

Acknowledgments

1. Applicants' argument filed on March 3, 2008 is acknowledged. Accordingly claims 1-33 and 37 remain pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1-2, 5, 7-10,12-13,16,18, 19-21, 23-24, 27, 29-31, and 32,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 A1 in view of Stupek Jr. et al Patent No. 5,960,189.

4. As per **claim 1, 12 and 23**, Aldis et al discloses a method comprising:

maintaining a software license bank for a customer, software licenses stored in the software license bank not being associated with specific machines (fig.1 and 11; 0013, 0014, 0018, claim 61); and

accessing a web application to allow a user to automatically obtain a software license for a specific machine from the software license bank, wherein the software

license is associated with a first license key (figs.1, 6 and 7; 0014, 0016, 0017, 0018, 0021, 0023, 0061, 0153).

5. What Aldis et al does not explicitly teach is

downgrading software associated with first license key including obtaining a second license key and disabling the first license key, such that the customer does not have rights to run the previous version of the software.

6. Stupek Jr. et al discloses a method comprising downgrading software associated with first license key including obtaining a second license key and disabling the first license key (col. 5, line 65-col. 6, line 45 "…maintaining old versions of upgraded resources allows the user to downgrade the resource if needed in the future….", see claim 29; ….downgrading …resource from newer version back to old version….).

7. Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method of downgrading software associated with first license key including obtaining a second license key and disabling the first license key in view of the teachings of Stupek Jr. et al since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

8. As per **claim 2, 13 and 24**, Aldis et al further discloses the method, wherein the software licenses available from the software license bank depend on a predetermined

contract (0022).

9. As per **claim 5, 16 and 27**, Aldis et al further discloses the method, wherein the software license bank contains an unlimited number of licenses for some period of time (fig. 2 and 4, 0078).

10. As per **claim 7, 18 and 29**, Aldis et al further discloses the method, wherein the web application maintains digital records of software licenses, the digital records indicating rights associated with the software licenses (fig. 2, and 4, 0005, 0015, claim 79).

11. As per **claim 8, 19 and 30**, Aldis et al further discloses the method, wherein web application can be used to adjust the rights associated with the software license (0022, 0069, 0097).

12. As per **claim 9, 20 and 31**, Aldis et al further discloses the method, wherein the web application is used to provide license keys for the software (see figs. 2 and 19, 0077, 0087, claim 40).

13. As per **claim 10, 21 and 32,** Aldis et al further discloses the method, wherein the web application uses role based security (fig.1; 0021, 0022, 0023).

14. **Claims 3, 4, 6, 11, 14, 15, 17, 22, 25, 26, 28, and 33,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 in view of Stupek Jr. et al U.S. Patent No. 5,960,189 and further in view of Watanabe et al U.S. Patent Application Publication 2003/0182146 A1.

15. As per **claim 3, 14 and 25**, both Aldis et al and Stupek Jr. et al failed to explicitly disclose the method, wherein the software license bank stores predetermined dollar amount of licenses.

16. Watanabe et al discloses the method, wherein the software license bank stores predetermined dollar amount of licenses (figs. 3 and 4; 0038).

17. Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores predetermined dollar amount of licenses in view of the teachings of Watanabe et al since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

18. As per **claim 4, 15 and 26**, Aldis et al and Stupek Jr. et al failed to explicitly disclose the method, wherein the software license bank stores a predetermined CPU count of software licenses.

19. Watanabe discloses the method, wherein the software license bank stores a predetermined CPU count of software licenses (fig. 3; …number of license leases…).

20. Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores a predetermined CPU count of software licenses in view of the teachings of Watanabe since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

21. As per **claim 6, 17 and 28**, Aldis et al and Stupek Jr. et al failed to explicitly disclose the method, wherein the software license bank stores a predetermined user count of software licenses.

22. Watanabe discloses the method, wherein the software license bank stores a predetermined user count of software licenses (fig. 3; 0027; …number of customers…).

23. Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores a predetermined user count of software licenses in view of the teachings of Watanabe since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in

the art would have recognized that the results of the combination were predictable.

24. As per **claim 11, 22, and 33**, both Aldis et al and Horstmann failed to explicitly disclose the method, wherein the web application stores configuration information for the computers running the licensed software.

25. Watanabe et al discloses the method, wherein the web application stores configuration information for the computers running the licensed software (0032).

26. Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the web application stores configuration information for the computers running the licensed software in view of the teachings of Watanabe et al since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

27. **Claims 37,** is rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 in view of Watanabe et al U.S. Patent Application Publication 2003/0182146 A1.

28. As per **claim 37**, Aldis et al discloses a method comprising:

maintaining a software license bank for a customer, software licenses stored in the software license bank not being associated with specific machines (fig.1 and 11; 0013, 0014, 0018, claim 61); and

accessing a web application to allow a user to automatically obtain a software license for a specific machine from the software license bank, wherein the software license is associated with a first license key (figs.1, 6 and 7; 0014, 0016, 0017, 0018, 0021, 0023, 0061, 0153).

Upgrading/downgrading software associated with first license key including obtaining a second license key and disabling the first license key (0099; 0100; 0105; 0119), such that the customer does not have rights to run the previous version of the software.

29. What Aldis et al does not explicitly teach is:

wherein the software license bank stores a predetermined dollar amount of licenses.

30. Watanabe et al discloses wherein the software license bank stores a predetermined dollar amount of licenses (figs. 3 and 4; 0035; 0038; …unit price of license key lease…made under contract…).

31. Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores predetermined dollar amount of licenses in view of the teachings of Watanabe et al since the claimed invention is merely a combination of old and known elements, and in the combination each element merely

would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

32. Applicant's arguments filed March 11, 2008 have been fully considered but they are not persuasive.

33. With respect to **claims 1, 12, 23 and 37**, Applicant argues that the prior art of record does not disclose or suggest that the disabling of the first license key is "such that the customer does not have rights to run the previous version of the software."

34. In response, Examiner submits that first of all the claimed limitation is inherent in software upgrade and downgrade. Examiner interprets "downgrade" as replacement of current version with the old or previous version. This is because when the software is upgraded or downgraded, the current version that is upgraded or downgraded is replaced by the previous version and the current version that is downgraded is no longer in existence. It has been replaced or substituted by the version that is used to upgrade or downgrade it. Because the downgraded version or the current version is inactivated and the previous or old version is activated the user cannot and does not have rights to run the software that is no longer existing (the replaced version). This interpretation is supported by the following Patents: 2004/0015940 to Heisey et al which discloses that an embedded software image is reverted to a previous version; 5,499,357 to Sonty et al, which discloses complete or partial downgrades; 2002/0069316 A1 to

Mattison which discloses where each different version of the program or update has a different key ... which can be updated without going through all revisions in between (0024); 5,843,138 to Evers et al which discloses changing the program permissions, e.g., disabling the permission for the old type and enabling the permission for the updated type; and programming parameters and software according to the upgrade type.

35. It is examiner's position that the reference in Stupek et al that the user always has access to previous versions of the resources is intended when the user wants to downgrade in the future as the next sentence clearly stated: …"maintaining old versions of upgraded resources allows the user to downgrade the resource, if needed in the future." For this reasons it is inherent that when software is downgraded, the license is replaced with the license of the software version that is being installed and the user has no rights to run the previous version as claimed.

Conclusion

36. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

37. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

38. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art ad are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is (571) 272-6838. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on **(571) 272 – 6779**.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charlie C Agwumezie
Examiner, Art Unit 3621
May 27, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621